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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,667	02/15/2002	Allon G. Engelman	47079-00127USPT	2996
70243	7590	11/07/2008		
NIXON PEABODY LLP			EXAMINER	
161 N CLARK ST.			HSU, RYAN	
48TH FLOOR				
CHICAGO, IL 60601-3213			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			11/07/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/077,667

**Applicant(s)**

ENGLMAN, ALLON G.

**Examiner**

RYAN HSU

**Art Unit**

3714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-7,9-15,17,18,25-31,33,35,37-39 and 41-52  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

Continuation of 11, does NOT place the application in condition for allowance because: The arguments presented by the applicant's representatives are not persuasive. In the reply to the final office action filed 10/21/08 the applicant makes 5 arguments against the prior art of record which are: a) osawa does not teach the claim elements related to the "reset" feature; b) Osawa does not teach the element of "playing" of the bonus game and "returning" to the basic game; c) Osawa teaches away from its combination with Feinberg; d) Feinberg teaches away from the present invention and teaches away from its combination with Osawa; e) The Stated Reasoning for combining Feinberg with Osawa is not entirely accurate because it misinterprets the Feinberg's Teaching. Regarding argument a, Osawa does teach a "reset" feature and as characterized by the applicant's remarks is done in response to a "predetermined condition. In the broadest reasonable interpretation this could mean any condition as determined by a game designer such as before the play of any game or coin. This concept is not novel in the gaming arts. Additionally, Osawa teaches providing the player with different options of whether to reset or not. Therefore in the embodiments provided for playing the game of Osawa a player could select to reset the accumulation feature of the video game before playing the primary game (see col. 10: In 18-45). With respect to argument "b", The applicant's representative claims that the player does not actually "play" the bonus game and "return" to the basic game. Examiner respectfully disagrees, while the bonus game element of Osawa does not ask the player to actually input and interact with the bonus game itself, the player via the use of the results from the bonus game does participate and play the game in order to win the prize. While the applicant's view seems to believe that this is simply an extension of the basic game, the element is a separate game that is played/participated by the player to gain the bonus award and then the player is returned back to the base game. Therefore Osawa does in fact teach such a feature. With respect to Osawa teaching away from its combination with Feinberg, Examiner further disagrees. While in an embodiment of Osawa does provide the "vulturing" effect discussed by the applicant as discussed above, Osawa provides the player with the option of resetting the accumulation feature which would provide the same end result as applicant's "inventive concept". Furthermore, the applicant provides assumptions underlying Osawa that mischaracterize the motives of the invention and the claims that hindsight was used. Feinberg's teaching of the single bet wager provides an alternative method of proposing a wager for a game to a player. Based on Feinberg's observation of a single-wager feature by paying for multiple games at one turn enhances player interest as it attracts more customers. The ultimate objective of all wagering games is to attract more game play. By providing this type of betting method, one can observe from the teachings that this would increase the number of people playing the game and therefore provide a greater amount of money to flow through the game machine. Therefore it would have been obvious to implement and incorporate such a betting feature into a wagering game and preserve the integrity of the two pieces of prior art. With respect to argument "d", the gaming machines taught in both patents are directed towards "wagering games". If applicant does not like the commonly accepted scope of the term "wagering games" it is suggested that the scope is further limited. Feinberg's chance game while might be simple still qualifies as a wagering game and therefore meets the limitations set forth in the instant claims. Osawa being another type of wagering game could still look to Feinberg for teachings in the type of wagering offers provided to the user. Examiner also disagrees that Feinberg is not properly teaching the invention because of the "relatively simple gaming format". Feinberg teaches a wagering game therefore is included in the scope of a wagering game "patent". Additionally, Feinberg clearly teaches the so called "block wagering" method described in the applicant's invention and while it is argued that Feinberg does not implement it in a term the applicant's representative would classify as a "complex wagering game" the betting method is the same. As such, the implementation of the betting method first incorporated in a simple wagering game implemented into a complex wagering game still does not satisfy the condition of being a novel element. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. In this case the use of a complex wagering game clearly provides a predictable result when placed in view of Feinberg.